

### **REMARKS**

Prior to entry of this paper, Claims 35-39 and 46-63 were pending. In this paper, Claims 36 and 60 are amended. Claims 35-39 and 46-63 are currently pending. No new matter is added by way of this amendment. For at least the following reasons, Applicants respectfully submit that each of the presently pending claims is in condition for allowance.

#### **Allowable Subject Matter (Claims 36 and 60)**

Claims 36 and 60 were identified as being allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in the Office Action of April 19, 2007, and in independent form.

The rejection to Claims 36 and 60 are respectfully submitted to be moot. Claims 36 and 60 are respectfully submitted to depend from allowable claims for at least the reasons stated below. For at least these reasons, it is respectfully submitted that claims 36 and 60 are in condition for allowance, and notice to that effect is earnestly solicited.

#### **Rejection of Previously Allowed Claims (Claims 35 and 37-39)**

With regard to Claim 35, 38, and 39, it is respectfully submitted that the Office failed to exercise "great care" in rejecting previously allowed claims. See, e.g., MPEP 706.04 and the cases cited therein. Also, the Office should have used Form Paragraph 7.50 to make it clear on the record a previously allowed claim is being rejected.

Claims 35, 38, and 39 are respectfully submitted to be in condition for allowance at least for the reasons for which Claims 35, 38, and 39 were previously allowed by the Examiner.

It is respectfully submitted that Claim 35 is allowable at least for the reasons for which Claim 35 was previously allowed. Claims 37-39 are respectfully submitted to be allowable at least because they depend from Claim 35.

**Rejections under 35 U.S.C. § 112 (Claims 36, 55 and 60)**

Claims 36, 55 and 60 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The rejection to Claims 36 and 60 are respectfully traversed. It is respectfully that the rejections to Claims 36 and 60 should have been objections, not rejections. "When the meaning of the claim would reasonably be understood by persons of ordinary skill when read in light of the specification, the claim is not subject to invalidity upon departure from the protocol of 'antecedent basis.'" *Energizer Holds, Inc. v. Int'l Trade Comm'n* (Fed. Cir. 2006). However, the point is moot in light of the amendment to Claims 36 and 60.

The rejection to Claim 55 is respectfully traversed. Claim 55 was rejected on the grounds that "recitation of 'substrate' in additional to the previously claimed 'semiconductor material' (claim 46) ambiguously suggests two separate elements, wherein the specification suggests that these are one in the same (e.g., semiconductor substrate 301)." Applicants respectfully disagree. Claim 55 recites that the substrate includes one or more sensors. Claim 46 recites that the one or more sensors includes a semiconductor material. It follows logically from these two recitations that the substrate includes a semiconductor material (logically, given that X includes Y and Y includes Z, it follows that X includes Z). Accordingly, there is no ambiguity in Claim 55.

**Rejections under 35 U.S.C. § 103 (Claims 35, 37-39, 46-59, and 61-63)**

Claims 35, 38-39, 46-48, 50-59 and 62-63 were rejected under 35 U.S.C. 103(a) as being unpatentable over Meron et al., U.S. Patent Publication No. 2002/0109774 (hereafter "Meron") in view of McKenna et al., U.S. Patent No. 6,261,226 (hereafter "McKenna") and further in view of Yegnashankaran, U.S. Patent No. 6,881,943 (hereafter "Yegnashankaran"). Claims 37 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meron in view of McKenna and Yegnashankaran and further in view of Inaike et al., U.S. Patent No. 4,508,766 (hereafter "Inaike"). Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meron in view of McKenna and Yegnashankaran and further in view of Yu, U.S. Patent No. 6,300,612 (hereafter "Yu").

Each of the rejections is respectfully traversed.

The rejection of Claim 46 is respectfully traversed at least because the proposed combination fails to meet the limitation, "at least one of the one or more sensors includes a semiconductor material that is curved to shape to the contour", as recited in Applicants' Claim 46.

McKenna describes CCD imaging sensors that are arranged in continuous bands around the endoscope wall. However, in McKenna, the CCD sensors themselves are not curved. Rather, in McKenna, the sensors themselves are flat. See, e.g., FIGs. 22-24 of McKenna, which show that each of the CCD sensors 70 of McKenna is flat, and not curved.

Note that, in McKenna, each CCD image sensor is small relative to the capsule so that the **array** of CCD image sensors forms a curved **arrangement**, while each CCD image sensor itself is not curved. In contrast, Applicants' Claim 46 recites, "at least one of the one or more sensors includes a semiconductor material that is curved to shape to the contour".

Further, it is respectfully submitted that, at the time the invention was made, it would not have occurred to one of ordinary skill in the art that it would be possible to create a working imaging sensor with a semiconductor material curved to the shape of the contour, let alone would it have occurred to one of ordinary skill in the art how to make and use such a device, with or without undue experimentation. The state of the art at the time of the invention was that an operable semiconductor circuit needed to be flat. The semiconductor material includes transistors and/or other circuit elements that are conventionally part of flat semiconductor material. Without the Office presenting prior art or other objective evidence, that, at the time of the invention, an ordinary practitioner would even think of the possibility of creating a working imaging sensor composed of silicon that is curved to the shape of the contour; let alone the possibility of curving the circuitry without causing damages, tears, or the like; let alone a reasonable possibility of success of having such a device function even though it is curved, there is no support for a prima facie case of obviousness with regard to Claim 46.

The rejection is respectfully traversed with regard to Claim 35 at least for reasons similar, albeit different, to those stated above with regard to Claim 46. Claims 37-39 are respectfully submitted to be allowable at least because they depend from Claim 35. Claims 47-59 and 61-63 are respectfully submitted to be allowable at least because they depend from Claim 46.

**CONCLUSION**

It is respectfully submitted that each of the presently pending claims (Claims 35-39 and 46-63) is in condition for allowance and notification to that effect is requested. Examiner is invited to contact the Applicants' representative at the below-listed telephone number if it is believed that the prosecution of this application may be assisted thereby. Although only certain arguments regarding patentability are set forth herein, there may be other arguments and reasons why the claimed invention is patentable. Applicant reserves the right to raise these arguments in the future.

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Respectfully submitted,

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